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| 10/676,323 | 09/30/2003 | Leonard J. Stulc | SAM0021/US | 6477 |

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| EXAMINER |
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EINSMANN, MARGARET V

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| ART UNIT | PAPER NUMBER |
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1751

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,323

Applicant(s)

STULC, LEONARD J.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 16-23 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 2, 6-15 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/04; 4/20/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Applicant's election with traverse of Group I and the species of an ionically complexed black colorant compound comprising an anionic dye component complexed with a cationic dye component in the reply filed on 5/6/05 is acknowledged. The traversal is on several ground(s). The arguments presented are not found persuasive because of the following reasons.

Applicant traverses the restriction requirement by stating that is irrelevant that the colorant of the group I claims can be made by a different method because there is a fundamental commonality between the two groups. The examiner acknowledged the commonality between the two groups by designating claim 1 as a linking claim. The restriction of Groups I and II is deemed proper because the product can be made by a different process. The process of group II requires measuring and testing steps. Note the art used to reject the claims produces ionically complexed colorants which do not use a process of measuring and testing. Applicant states that groups II, IV and V have a common function, operation or effect which achieves its effect by the unique approach of having a first ionic component complexed with a second ionic component. That argument is not persuasive because Group II is a method of making a colorant, Group IV is directed to a product, which is a toner, and group V is an ink; An ink cannot function as a toner and the method of Group II does not make either a toner or an ink.

Applicant further argues that since the process of group II makes a component of each of groups II, IV and V, that is the product of group I, it is related to groups II, VI

and V. This office respectfully disagrees. The process of Group II does not produce an ink composition or a toner. It only produces a colorant, which colorant has various utilities, and can be incorporated into various products as claimed. Because they may each use or incorporate the colorant does not make the products, the ink, and the toner capable of use together. Applicant has not pointed to a teaching that the ink and toner or color concentrate, etc. are capable of being used together.

Regarding the restriction of groups I and (III, IV and V) applicant again argues the commonality of the colorant of claim 1 in each. The common element in each has been acknowledged from the onset. They are mutually exclusive products, have different modes of operation, functions and effects.

Applicant traverses the election of species requirement by stating that the species have substantial commonality. Applicant is directed to the art used to reject the elected species to see that the search did not find any art which included the non-elected species. Accordingly the burden of searching the four individual species is four-fold.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 1,2,6-15 and 24 are being examined in this action. Claims 3-5 have been withdrawn as being directed to non-elected species; claims 16-23 and 25 have been withdrawn as being directed to non-elected inventions.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6-15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated or under 103(a) as obvious over Mueller et al., US 2,922,690.

Dyestuff salts which are formed by complexing an anionic dye and a cationic dye are disclosed in column 2 lines 11-60. Patentee states in col 2 lines 40 et seq., "Naturally, it is possible to use, instead of one cationic and one anionic dyestuff, two or more of each kind simultaneously." He further states that it may be advantageous to replace part of the cationic dye and/or anionic dyestuffs with colorless cationic and/or anionic substances. Example 10 in column 7 discloses the formation of a salt by the

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mixture of a blue cationic dyes with an orange anionic dye. Since blue absorbs light in at least a portion of the visible spectrum and orange absorbs light in a portion of the visible spectrum that is not absorbed by blue, the dye salt will appear black in color. Regarding the limitations of claim 9, the dye is taught as being a precipitate. Regarding claim 10, no metal is seen in the compositions. Regarding claim 11 and 12, the combination comprises low molecular weight dye components.

Alternatively, the reference differs from the claims because there is no statement in example 10 that the dye salt appears black in color. It would have been obvious to the man having skill in the art at the time the invention was made to adjust the proportion of blue and orange to make a dye salt that appeared black in color because such adjustment of proportions to obtain any neutral color desired is within the skill of the artisan.

Claims 1-2, 6,9-14 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Chechak, GB 1,343,709.

Chechak describes a process of reacting an acidic dye with a basic dye so as to form a precipitate and then treating the precipitate with an acidic mordant. The acidic mordant thus meets the limitation of claim 14 as the ionic colorless component. The reference states that the acidic dyes preferably contain at least two sulfonic or carboxylic acid radicals and the basic dyes contain at least two amino radicals. See page 1 lines 13-40. Patentee states on page 2 lines 60-64 that impure cyan may be reacted with impure magenta to produce a black. These sections are seen to anticipate the instant claims. Regarding the limitations of claim 9, the dye is taught as being a

precipitate. Regarding claim 10, no metal is seen in the compositions. Regarding claim 11 and 12, the combination comprises low molecular weight dye components.

Claims 1,2,6,13 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Neier, US 3,406,162. Examples 30 and 33 in column 7 disclose ironically complexed black dyes comprising the basic dye Methyl Violet B, C. 42535 and a chromium complex anionic dye (example 30) or a cobalt complex anionic dye (Example 33) . Noting the top of col 5 and 6, the shade of color listed in the table, in this case black, is obtained by dissolving the dye salt in vinyl lacquer. This lacquer anticipates claim 24.

Claims 1-2, 6-13 and 15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall, US 4,130,435.

Hall describes a process wherein a water-soluble cationic dye and a water-soluble anionic dye are admixed and reacted to form a cationic-anionic dye salt which is solvent soluble and precipitates out from an aqueous phase. See col 1 lines 28-46. The specific cationic dyes and the specific anionic dyes which can be used are described in col 2 lines 17-44. Note examples, 3 and 4 from col 3 line 45 to col 4 line 34 which disclose the formation of black complexed colorants. In esample 3 the black colorant is formed by the mixture of two cationic dye components with one anionic dye component. Crystal Violet and Victoria Blue B are cationic dye components; Metanil Yellow is the anionic dye component. In example 4 one anionic and one cationic component are complexed to form a black colorant. Regarding the limitations of claim

9, patentee teaches in col 1 that the colorant is separated from the aqueous phase by precipitation. Regarding claim 10, no metal is seen in the compositions. Regarding claim 11 and 12, the combinations as disclosed all comprise low molecular weight dye components.

Claims 1,2,5,6, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koshida et al., US 2003/0065074 A1. Koshida teaches formation of a black dye which is the amine salt of an anthraquinone dye of Formula I as disclosed in [0009]. The anthraquinone dye is an anionic component. Applicant states that the amine salt may be formed wherein the cation is derived from a basic dye. Patentee differs from the instant claims because there is no example of the black anthraquinone dye salt formed wherein the cation is a basic dye. It would have been obvious to one having skill in the art at the time the invention was made to formulate the black dye as claimed because Koshida teaches that said black dye is equivalent to the black dyes formed wherein the ammonium ion is an ammonium ion as shown in the examples. Also relevant is that patentee explicitly lists basic dyes which can be used to formulate the black dye. See [0027] and [0028]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-W and

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alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Friday, May 27, 2005


Margaret Einsmann
Primary Examiner
Art Unit 1751